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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,160	08/10/2001	Manabu Yoshimura	33035M077	4910

441 7590 12/23/2002

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EXAMINER

LIN, TINA M

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,160

Applicant(s)

YOSHIMURA ET AL.

Examiner

Tina M Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The preliminary amendment filed on November 3, 2001 has been entered.

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. 119(a)-(d).

Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2 (a)).

The abstract of the disclosure is objected to because the abstract is too long. The abstract should not exceed over 150 words. Examiner has counted 187 words. Correction is required. See MPEP § 608.01(b).

The specification is objected to by the examiner. On page 11 Line 19, the examiner believes the word "plain" should be --plane--. Correction is required if necessary. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,127,074 to Watanabe et al. In Figure 1, Watanabe et al. teaches an optical semiconductor module comprising a mounting member 32, a first tubular member 12a, a second

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tubular member 12b, an optical semiconductor element 34, and an optical waveguide 44 optically coupled to the semiconductor element. Additionally, it can be observed from Figure 1, a third member 16 having an opening for the optical fiber to extend through the first and second end faces of the ferrule 42. Furthermore, Watanabe et al. teaches an optical semiconductor module with a lens 22 between a waveguide and semiconductor element and where this semiconductor element is a light emitting element. (Column 3 Line 30) Finally, Watanabe et al. teaches an annular connecting portion to surround the optical axis of the optical semiconductor element. (Column 3 Lines 52-65)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,127,074 to Watanabe et al. as applied to claims 1 and 4 above, and further in view of U.S. Patent 5,661,834 to Watanabe et al. U.S. Patent '074 discloses all of claims 1 and 4 above but fails to disclose a sleeve arranged in a depressed portion of second member and another ferrule to be inserted in the second portion. However, U.S. Patent '834 does disclose an optical semiconductor module that comprises a ferrule to be inserted into a sleeve 13. In Figure 1, it can also be seen that the sleeve 13 is arranged on a depressed portion of the housing. Since it is well known in the art to use a sleeve for the purpose of additionally protecting and supporting an optical fiber, it would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to have included the use of a sleeve or an additional ferrule over the original ferrule for the purpose to better support and protect the fiber. Also, it is also well known in the art to use a depressed portion of a housing/member to create a shoulder in order for the sleeve or addition ferrule to be arranged on. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have used a depressed portion of a housing to arrange a sleeve on.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,127,074 to Watanabe et al. as applied to claim 1 above. Watanabe discloses all of claim 1 and the mounting member 32 with a center axis perpendicular to the reference surface, but fails to disclose a mounting member having a diameter of not more than 4mm. However, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have used a mounting member of an appropriate size for the desired size of the overall module.

The documents submitted by applicant in the Information Disclosure Statement have been considered and made of record. Note attached copy of form PTO-1449. With regards to the foreign documents, the examiner has considered the documents to the fullest extent possibly through the figures and abstracts provided in English.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All the cited references discuss alternative methods for connecting semiconductor elements and fiber optic elements and the different types of assembly required for the connection.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various


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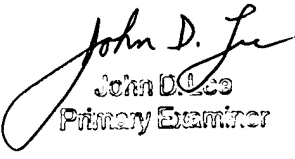
claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tina M Lin whose telephone number is (703) 305-1959. The examiner can normally be reached on Monday-Friday 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308-4819. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

TML 
December 18, 2002


John D. Lee
Primary Examiner